

REMARKS

Claims 1, 6 and 12 have been amended to clarify the claim language. Claim 1 has been amended to further define the test, support for which is found, for example, on page 4, line 20 through page 5, line 19. Further, the natural inhibiting compound has been clarified to define the compound as one that inhibits microbial growth, as described in the sentence bridging pages 1 and 2 of the present application. Finally, claim 1 has been amended to indicate the negative results of the process. Claim 6 has been amended to clarify that the indicators are indicators of microbial growth, suggested on page 5, lines 24-29 of the present application. Claim 12 has been amended to reflect the new language in claim 1. Claim 13 has been added, support for which is found, for example, on page 8, line 21 of the present application. No new matter has been added.

Double-Patenting

Claims 1-6 and 12 have been provisionally rejected for obviousness-type double patenting over claims 1-8 and 14-16 of copending Application No. 10/089,874. Enclosed herewith is a terminal disclaimer. Accordingly, this basis for rejection may be withdrawn.

The Rejection Under 35 U.S.C. § 112, Second Paragraph

Claims 1-6 and 12 have been rejected as allegedly indefinite. This rejection is traversed. Nonetheless, claims 1 and 12 have been amended to define the natural inhibiting compound as a compound that inhibits microbial growth as described in the sentence bridging pages 1 and 2 of the present application. In addition, claim 1 has been amended to refer to the test as a test composition, the results of which test are based on microbial growth. In addition, claim 6 has been amended to

define the indicators as indicators of microbial growth. Accordingly, it is believed this basis for rejection may be withdrawn.

The Rejection Under 35 U.S.C. § 102

The rejection of claims 1, 6, and 12 under 35 U.S.C. § 102(b) as being anticipated by Charm (U.S. Patent 5,354,663) is traversed and reconsideration is respectfully requested. Charm does not disclose the order of the steps as claimed. Specifically, present claim 1's step ii) requires heating the *contacted sample* and *test composition* to inactivate any inhibiting compound. Thus, the contacting step i) must occur before step ii). In contrast, Charm does not disclose such step. In fact, the Office action on page 5 alleges that Charm's steps include a) heating the sample [without the test] to destroy the inhibitors and b) adding a test to the sample and incubating it. These steps do not anticipate the present claims, which heat the sample *and test* to destroy the inhibitors. Thus, the Office has not established anticipation, and withdrawal of this rejection is requested.

Rejection of claims 1-6 and 12 under 35 U.S.C. § 102(b) as being anticipated by Inglis is traversed and reconsideration is respectfully requested. The Office action alleges that the samples and test organisms (spores) are heated to 85°C and then subsequently added to agar plates to determine whether spore growth was inhibited. However, like Charm, Inglis discloses either preparing the standards or preparing a raw egg mixture which is then heated to 85°C and centrifuged. The centrifugate is the assay solution, which is then added to petri dishes. The petri dishes were inoculated with the spores, but the petri dishes were not heated with the spores to 85°C. There is no disclosure that the sample *and test* are heated to 85°C, in contrast to the present claims. Thus, anticipation has not been established, and this rejection may be properly withdrawn.

The rejection of claims 1-6 and 12 as allegedly anticipated under 35 U.S.C. § 102(b) over Katz is traversed and reconsideration is requested. Katz refers to the cited Inglis reference described above for the procedure for *Measurement of Potency and Assay of Residues in Eggs*. Similarly, Katz describes heating a standard or an egg mixture to 80-85°C and thereafter adding the centrifuged standard or mixture to petri dishes inoculated with the spores, which petri dishes are not heated to 80-85°C. Therefore, as described above with respect to Inglis and Charm, the steps of the present invention are not disclosed.

The Rejections Under 35 U.S.C. § 103

Applicants traverse the rejection of claims 1-6 and 12 as allegedly obvious over Charm. The arguments above with regard to the anticipation rejection over Charm are incorporated herein. As all of the elements of the present claims are not provided, *prima facie* obviousness has not been established. Thus, this rejection may be properly withdrawn.

Applicants wish to bring to the Examiner's attention that the applicants' counsel conducted an interview with Examiners Robert Wax and Rosanne Kosson, and it was agreed that Charm did not anticipate the claims in Application Serial No. 10/089,874, which was cited in the double patenting rejection in this present Office action.

CONCLUSION


Thus, it is respectfully requested that the present claims are in condition for allowance and such action is respectfully requested. If the Examiner believes that a telephonic interview will expedite allowance of the case, he is kindly requested to telephone the undersigned.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket No. 246152016800.

Respectfully submitted,

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